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**MAR 30 2005**

**OFFICE OF PETITIONS**

In re Application of :  
Braig, Rule, Hartstein, and Smith : DECISION REFUSING STATUS  
Application No. 10/913,666 : UNDER 37 CFR 1.47(a)  
Filed: 6 August, 2004 :  
Atty Docket No. OPTIS.109A :

This is in response to the petition filed under 37 CFR 1.47(a) on 22 February, 2005.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

**FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.**

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 6 August, 2004, without an executed oath or declaration. Accordingly, on 18 October, 2004, a Notice to File Missing Parts of Nonprovisional Application was mailed, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on 22 February, 2005 (certificate of mailing 18 February, 2005), petitioners filed a two (2) month extension of time, the present petition, the late-filing surcharge, and a declaration naming James R. Braig, Peter Rule, Philip C. Hartstein, and Heidi S. Smith as joint inventors and signed by

all inventors except Smith on behalf of themselves and non-signing joint inventor Smith.

Petitioners assert that joint inventor Smith has failed to sign the declaration. In support, petitioners have provided a statement of facts by joint inventor Braig, stating that he sent a copy of the declaration to non-signing joint inventor Smith, but that she did not execute and return it.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks item (1).

In regards to item (1), petitioners have not shown that joint inventor Smith was sent or presented with a copy of the application as filed (specification, including claims, drawings, if any, and the declaration).<sup>1</sup> Based on the showing of record, it does not appear that the specification, including claims, and the drawings, were among the application papers sent to the non-signing inventor.

Petitioners may show proof that a copy of the application was sent or given to the non-signing inventor for review by providing a copy of the cover letter transmitting the application papers (specification, including claims, drawings, if any, and the declaration) to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal to sign the declaration can be alleged, petitioners must show that a copy of the application was sent or given to the inventor. If the inventor refuses in

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<sup>1</sup>MPEP 409.03(d).

writing, petitioners must submit a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of fact.

Further correspondence with respect to this matter should be addressed as follows:

By mail:           Mail Stop Petition  
                  Commissioner for Patents  
                  P.O. Box 1450  
                  Alexandria, VA 22313-1450

By FAX:           (703) 872-9306  
                  Attn: Office of Petitions

By hand:          Customer Service Window  
                  Mail Stop Petition  
                  Randolph Building  
                  401 Dulany Street  
                  Alexandria, VA 22314

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.



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Office of Petitions